Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte VIKRAM KHETANI,
YALIN LUO, and
SOWMIANARAYANAN RAMASWAMY

Appeal No. 2002-1816
Application No. 09/283,645

ON BRIEF

WINTERS, WILLIAM F. SMITH, and MILLS, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

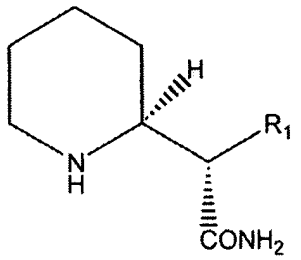
DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 8, 10 through 13, and 15, which are all of the claims remaining in the application.

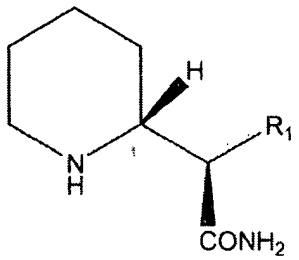
Representative Claim

Claim 1, which is illustrative of the subject matter on appeal, reads as follows:

1. A synthetic process for preferentially forming *d-threo* acid salts of *d-threo* piperadyl acetamide stereoisomers with respect to *l-threo* piperadyl acetamide stereoisomers comprising the steps of providing a mixture of said *d,l-threo* piperadyl acetamide stereoisomers having formulas:



l-threo



d-threo

wherein R_1 is aryl having about 6 to about 28 carbon atoms; and

reacting said stereoisomers with an acid resolving agent in an organic solvent.

The References[1]

In rejecting the appealed claims on prior art grounds, the examiner relies on the following references:

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[1] We have not overlooked the examiner's citation of U.S. Patent No. 4,410,700 issued October 18, 1983, to Kenner C. Rice; or Morrison and Boyd, Organic Chemistry, 3rd edition, pp. 32-34 (1973). See the Examiner's Answer (Paper No. 19), page 5, second full paragraph and page 7, second full paragraph. Those references, however, were not included in the statement of any rejection before us. As stated in In re Hoch, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n. 3 (CCPA 1970), "[w]here a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection." Accordingly, we note the examiner's citation of the afore-mentioned references but have not considered them further in our deliberations.

Patrick et al. (Patrick), "Synthesis of Deuterium-Labelled Methylphenidate, p-Hydroxymethylphenidate, Ritalinic Acid and p-Hydroxyritalinic Acid," J. Label. Comp. Pharm., Vol. 9, pp. 485-490 (1982)

Jursic et al. (Jursic), "Determination of Enantiomeric Composition of 2-Phenyl-2-(2-piperidyl)acetamide. A routine Method for Evaluation of Enantiomeric Purity of Primary Amides," Tetrahedron: Asymmetry, Vol. 5, No. 9, pp. 1711-1716 (1994)

Ohashi et al. (Ohashi), Chemical Abstracts 104: 186157 (1985)

Berrang et al. (Berrang), Chemical Abstracts 97:38738 (1982)

Vanderplas et al. (Vanderplas), Chemical Abstracts 118:101538 (1992)

In rejecting the appealed claims under the judicially created doctrine of obviousness-type double patenting, the examiner relies on claims 1 through 9 of the following reference:

Khetani et al. (Khetani) 5,936,091 Aug. 10, 1999

The Rejections

Applicants' claims stand rejected as follows: (1) claims 1 and 15 under 35 U.S.C. § 102(b) as anticipated by Jursic; (2) claims 1 through 8, 10, 11, 13, and 15 under 35 U.S.C. § 103(a) as unpatentable over Jursic in view of Berrang, Ohashi, or Vanderplas; (3) claim 12 under 35 U.S.C. § 103(a) as unpatentable over Jursic in view of Berrang, Ohashi, or Vanderplas, further taken in view of Patrick; and (4) claims 1 through 8, 10 through 13, and 15 under the judicially created doctrine of obviousness-type double patenting over claims 1 through 9 of U.S. Patent No. 5,936,091. See the Examiner's Answer (Paper No. 19), § (10).

Deliberations

Our deliberations in this matter have included evaluation and review of the following materials: (1) the instant specification, including all of the claims on appeal; (2) applicants' Appeal Brief[2] (Paper No. 18); (3) the Examiner's Answer (Paper No. 19); and (4) the above-cited references except for U.S. Patent No. 4,410,700 issued October 18, 1983, to Kenner C. Rice and Morrison and Boyd, Organic Chemistry, 3rd edition, pp. 32-34 (1973) (see footnote 1).

On consideration of the record, including the above-listed materials, we affirm each of the examiner's rejections.

Grouping of Claims

As stated in the appeal Brief, § VII, "[a]ppellants believe that claims 1-8, 10-13, and 15 stand or fall together." Accordingly, with respect to each ground of rejection which applies to more than one claim, we have treated all claims as standing or falling with the broadest claim on appeal, viz., claim 1. See 37 CFR § 1.192(c)(7) and (c)(8) (2001).

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[2] It would appear that the Appeal Brief received March 20, 2002, is missing page 7. We have reviewed each copy of applicants' Appeal Brief, but have been unable to find page 7. Accordingly, our deliberations have not included evaluation of that page.

35 U.S.C. § 102(b)

Applicants argue that Jursic does not constitute an anticipatory reference because Jursic does not disclose (1) the claimed "acid resolving agent," (2) the claimed formation of acid salts, or (3) the claimed step of isolating said acid salts (Paper No. 18, pages 4 through 6). The argument lacks merit.

First, unlike claim 15, claim 1 does not recite the formation of acid salts or the step of isolating those acid salts as positive manipulative steps in the body of the claim. To this extent, applicants would argue patentability based on limitations not found in claim 1 before us. As previously indicated, we shall treat claim 15 as standing or falling together with claim 1 with respect to the rejection under 35 U.S.C. § 102(b).

The principal argument centers on the recitation of "acid resolving agent" in claim 1. Here, we agree with the examiner's finding that the chiral resolving agents illustrated by Jursic in Figure 2 (page 1712) meet the terms of "an acid resolving agent" in claim 1. In fact, Jursic expressly refers to "the acidity of the amide hydrogen" in describing the resolving agents illustrated in Figure 2. Jursic discloses that these resolving agents, in an organic solvent such as chloroform or methanol, may be used to determine the stereo isomeric composition of 2-phenyl-2-(2-piperidyl) acetamide. As best we can judge, applicants' arguments on this point rely on limitations not found in claim 1 before us (see Paper No. 18, pages 4 and 5).

In the preamble of claim 1, applicants recite "[a] synthetic process for preferentially forming d-threo acid salts of d-threo piperidyl acetamide stereoisomers with respect to l-threo piperidyl acetamide stereoisomers." Again, in contrast with claim

15, applicants do not positively recite the formation of acid salts as a manipulative step in the body of claim 1 on appeal. Further, as explained by applicants, their acid salts are "obtained via resolution" (specification, page 8, line 4). On these facts, we find that the PTO has sound basis for believing that the same acid salts are obtained in carrying out Jursic's process where chiral resolving agents, in an organic solvent such as chloroform or methanol, may be used to determine the stereoisomeric composition of 2-phenyl-2-(2-piperidyl) acetamide. Applicants have the burden of showing that they are not. See In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) ("when the PTO shows sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not").

Accordingly, we affirm the rejection of claim 1 under 35 U.S.C. § 102(b) as anticipated by Jursic. As previously indicated, claim 15 falls together with claim 1.

35 U.S.C. § 103(a)

We shall not belabor the record with an extensive discussion of the examiner's rejection on grounds of obviousness. Rather, we note that claim 1 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Jursic in view of "secondary" references. As should already be clear, we agree with the PTO's finding that the process recited in claim 1 "reads on" the process disclosed by Jursic. In other words, there is no difference between the subject matter sought to be patented in claim 1 and the synthetic process disclosed by Jursic.

As stated in In re Pearson, 494 F.2d 1399, 1403, 181 USPQ 641, 644 (CCPA 1974), "lack of novelty in the claimed subject matter, e.g., as evidenced by a complete disclosure of the invention in the prior art, is the 'ultimate or epitome of obviousness'." On this basis, we affirm the rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Jursic in view of "secondary" references. As previously indicated, claims 2 through 8, 10, 11, 13, and 15 fall together with claim 1.

We summarily affirm the rejection of claim 12 under 35 U.S.C. § 103(a) as unpatentable over Jursic in view of Berrang, Ohashi, or Vanderplas, further taken in view of Patrick. In so doing, we note that applicants have not argued this rejection in their Appeal Brief or even acknowledged that it presents an issue remaining for resolution. See Paper No. 18, § VI.

Obviousness-Type Double Patenting

Considering now the rejection of claims 1 through 8, 10 through 13, and 15 for obviousness-type double patenting over claims 1 through 9 of Khetani, we affirm this rejection in the absence of a substantive rebuttal by applicants. In their Appeal Brief (Paper No. 18), applicants do not controvert the obviousness-type relationship between the two sets of claims. Rather, applicants submit that "this rejection should be deferred pending resolution of the issues of . . . anticipation and obviousness" and that "it would be premature for Appellants to submit a terminal disclaimer . . . until the identity of the allowed claims has been established" (id., footnote 1). On the contrary, the rejection for

obviousness-type double patenting is properly before us and applicants have not filed an appropriate terminal disclaimer.

Conclusion

In conclusion, we affirm the rejection of claims 1 and 15 under 35 U.S.C. § 102(b) as anticipated by Jursic. We also affirm the rejection of claims 1 through 8, 10, 11, 13, and 15 under 35 U.S.C. § 103(a) as unpatentable over Jursic in view of "secondary" references; and we affirm the rejection of claim 12 under 35 U.S.C. § 103(a) as unpatentable over Jursic in view of Berrang, Ohashi, or Vanderplas, further taken in view of Patrick. Finally, we affirm the rejection of claims 1 through 8, 10, through 13, and 15 for obviousness-type double patenting over claims 1 through 9 of Khetani.

The examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Sherman D. Winters)
Administrative Patent Judge)
)
William F. Smith) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
)
Demetra J. Mills) INTERFERENCES
Administrative Patent Judge)

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